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11 **UNITED STATES DISTRICT COURT**  
12 **NORTHERN DISTRICT OF CALIFORNIA**  
13 **SAN JOSE DIVISION**

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18 IN RE ACACIA MEDIA  
TECHNOLOGIES CORPORATION

Case No. C05-01114-JW (HRL)

**DEFENDANTS' RESPONSE TO ACACIA  
MEDIA TECHNOLOGIES  
CORPORATION'S OBJECTIONS TO THE  
ORDER APPOINTING RAINER SCHULZ  
AS A TECHNICAL CONSULTANT**

**DATE:** N/A  
**TIME:** N/A  
**CTRM:** Hon. Howard R. Lloyd

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22 Defendants<sup>1</sup> hereby submit their joint response to Acacia Media Technologies  
23 Corporation's Objections to the Order Appointing Rainer Schulz as a Technical Consultant.

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26 <sup>1</sup> The following defendants have notified CoxCom, Inc.'s and Hospitality Network, Inc.'s counsel that they join in  
27 this motion: The DirecTV Group, Inc.; Charter Communications, Inc.; Ademia Multimedia, LLC; AEBN, Inc.;  
28 Audio Communications, Inc.; Club Jenna, Inc.; Cyber Trend, Inc.; Cybernet Ventures, Inc.; ACMP, LLC; Game  
Link, Inc.; Global AVS, Inc.; Innovative Ideas International; Lightspeed Media Group, Inc.; National A-1  
Advertising, Inc.; New Destiny Internet Group, LLC; VS Media, Inc; International Web Innovations and Comcast  
Cable Communications, LLC.

1     **I.     INTRODUCTION**

2             Although Acacia repeatedly professes support for the appointment of Mr. Rainer Schulz  
3     as a technical advisor for the Court and does not challenge the Court’s authority to do so, it  
4     inappropriately seeks the re-designation of Mr. Schulz as a Rule 706 expert. Acacia currently  
5     asks the Court for this re-designation based on its unfounded speculation that the Court misused  
6     the technical advisor in issuing its July 2004 *Markman* Order, and that the Court will misuse the  
7     technical advisor in the future. Acacia’s charges belie the Court’s intended use of Mr. Schulz as  
8     articulated in its Order, which specifically prohibits Mr. Schulz from providing any evidence to  
9     the Court. (Block Decl., Ex. 1, Page 7) (“Mr. Schulz will make no written findings of fact and  
10    will not supply any evidence to the Court”). Acacia’s objections, unsupported by evidence and  
11    cobbled together with false inferences, should be rejected.

12    **II.    LEGAL ARGUMENT**

13           **A.    The Court’s Proposed Order Appointing Rainer Schulz Is Consistent With**  
14           **Acacia’s Prior Requests Regarding the Terms of Appointment of the**  
15           **Technical Advisor.**

16           Acacia’s current objections contradict its prior long-standing support for the Court’s  
17    appointment of Mr. Schulz as a technical advisor.<sup>2</sup> In 2004, Acacia stipulated to the appointment  
18    of Mr. Schulz, although it proposed certain modifications to the terms of the Court’s appointment  
19    order, each of which were adopted by the Court. (Block Decl., Ex. 2; Daley Decl., Ex. 1 at 2-3).  
20    Throughout that process, Acacia indicated no objection to the Court’s preclusion of Mr. Schulz  
21    being called to testify as a witness in the case, despite the Court’s reference to Federal Evidence  
22    Code Section 706, which the Court addressed and corrected in its June 21, 2005 Order Clarifying  
23    the Role of the Court’s Technical Advisor, Mr. Rainer Schulz. (Block Decl., Ex. 1, Page 6).  
24    Acacia understood that Mr. Schulz would “serve as a consultant for the Court on the technology

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25    <sup>2</sup> Acacia again challenges the very Order – appointing Mr. Rainer Schulz as a technical advisor to the court – it  
26    supported and had modified to its preference. Evidencing its prior support is Acacia’s own statement to the Court:  
27    “Plaintiff does not object to the appointment of Mr. Schulz.” (Daley Decl., Ex. 1 at 1). Acacia then sought changes  
28    to that Order, which the Court approved as requested. (Block Decl., Ex. 2, Page 11). Only after the Court  
   determined in its *Markman* Order that the claim limitations “sequence encoder” and “identification encoder” may be  
   indefinite, Acacia suddenly asserted that the Court’s Order appointing Mr. Schulz was “unclear.” (Block Decl., Ex.  
   9, page 64).

1 issues only involved in this case” and would be precluded from being examined by the parties.  
2 (*Id.*, Ex. 2, Page 10-11)

3 **B. Acacia’s Proposal to Treat the Court’s Technical Advisor as a Rule 706**  
4 **Expert is Unnecessary.**

5 Nevertheless, Acacia now seeks a new Order that Mr. Schulz be designated as a Rule 706  
6 expert so that Acacia can force Mr. Schulz to disclose the nature and content of his  
7 communications to the court, and to be deposed. (Acacia’s Mem. at 13). Acacia’s own brief cites  
8 a Ninth Circuit decision in which the Court found proper a district court’s refusal to allow the  
9 court-appointed technical advisor to be examined by or required to submit an expert report to the  
10 parties. (*Id.* at 8). *Assoc. of Mexican-American Educators v. California*, 231 F.3d 572, 591 (9th  
11 Cir. 2000) (en banc). Here, this is precisely what the Court has done; it has refused to allow the  
12 parties to depose Mr. Schulz. (Block Decl. at ¶ 5).

13 Acacia’s speculation that the Court improperly considered opinion testimony of Mr.  
14 Schulz in preparation of its *Markman* Order ignores the Court’s explicit statements to the  
15 contrary. (Acacia’s Mem. at 11). The Court based its findings of indefiniteness of the claim  
16 limitations “sequence encoder” and “identification encoder” on intrinsic evidence, not extrinsic  
17 expert opinion. (Daley, Ex. 2 at 33:21-23) (“Because the term ‘sequence encoder’ does not  
18 appear in the specification of the claim, extrinsic evidence, such as expert testimony, may not be  
19 useful to the Court, as the intrinsic evidence appears unambiguous”); (*Id.* at 35:21-23) (“Thus,  
20 one of ordinary skill in the art would not understand the scope or bounds of the claim, when it is  
21 read in light of the specification rendering the ‘identification encoder’ insolubly ambiguous.”).  
22 Contrary to Acacia’s arguments, the record reflects that the Court properly used Mr. Schultz as a  
23 consultant on the issues regarding the technology involved in the case in regard to the prior  
24 *Markman* analysis.<sup>3</sup>

25 Moreover, assuming *arguendo* that the Mr. Schulz did provide opinion testimony to the  
26 Court, and further assuming that the Court used such testimony in preparing its *Markman* Order,

27 <sup>3</sup> Defendants cite as additional support its Memorandum of Points and Authorities in Opposition to Acacia’s Motion  
28 for Clarification and Modification of Order Appointing Technical Consultant dated February 28, 2005, which is  
available in the Block Declaration, Exhibit 10.

1 the Court has already granted Acacia a suitable remedy, reconsideration of the allegedly tainted  
2 *Markman* Order. Acacia has already been granted reconsideration of the claim construction of  
3 any term or terms previously construed in the July 2004 *Markman* Order. Furthermore, to  
4 assuage Acacia's concern of future misuse, the Court clarified in its Proposed Order of  
5 Appointment that "Mr. Schulz will make no written findings of fact and will not supply any  
6 evidence to the Court." (Block Decl., Ex. 1, Page 7).

7 Finally, Acacia's own brief relies on three cases, all of which hold that Rule 706 does not  
8 apply to technical advisors. (Acacia's Mem. at 8). *Assoc. of Mexican-American Educators*, 231  
9 F.3d at 591; *Techsearch LLC v. Intel Corp.*, 286 F.3d 1360, 1378 (Fed. Cir. 2002); *FTC v.*  
10 *Enforma*, 362 F.3d 1204, 1213 (9th Cir. 2004). Given that Judge Ware has advised the parties  
11 that he has treated and will continue to treat Mr. Schulz as a technical advisor, there is no basis  
12 for Acacia to assert that Rule 706 applies or for its "solution" that is clearly contrary to Judge  
13 Ware's Order.

14 The Court's explicit statements in its *Markman* Order evidence no reliance on testimony  
15 from Mr. Schulz in the past, and the Court's Proposed Order of Appointment makes clear the  
16 Court's intention to explicitly preclude such evidence. Acacia's proposal to designate Mr. Schulz  
17 as a Rule 706 expert, in addition to thwarting the Court's legitimate purpose for appointing a  
18 technical advisor, is therefore unnecessary.

### 19 **III. CONCLUSION**

20 For the foregoing reasons, defendants respectfully request that the Court reject Acacia's  
21 objections and proceed with the appointment of Mr. Rainer Schulz as a technical consultant to the  
22 Court.

1 DATED: July 12, 2005

**COXCOM, INC. AND HOSPITALITY  
NETWORK, INC.**

2  
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